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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,373	11/09/2001	Marguerite B. McDonald	55915 79422	1045
44777	7590	12/20/2005		
W. EDWARD RAMAGE COMMERCE CENTER SUITE 1000 211 COMMERCE ST NASHVILLE, TN 37201			EXAMINER THALER, MICHAEL H	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TMA

Office Action Summary	Application No.	Applicant(s)	
	10/014,373	MCDONALD, MARGUERITE B.	
	Examiner	Art Unit	
	Michael Thaler	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28,29,31-34 and 39-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28,29,31-34 and 39-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Oct. 24, 2005 has been entered.

Claims 28, 29, 31-34 and 39-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how the invention is used. Figures 1b, 1c, 1d, 1g show the cannula oriented such that during its movement between the figure 1c position and the figure 1d position, its leading side is the concave side while the apertures (for directing medium 38) are oriented upwards (toward the viewer of the figures). However, the specification indicates that apertures 92 are on a lateral surface and that surface 91 is an upper surface (page 14, last line), suggesting that the apertures 92 may be facing laterally rather than upwardly as shown in figures 1b, 1c, 1d,

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1g. Thus, it is unclear from the disclosure as a whole, whether the apertures face upwardly or laterally.

Claims 28, 29, 31-34 and 39-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the original disclosure for the limitation in claim 28 that the curvature has a radius substantially equal to a radius of curvature of a cornea of a human eye.

Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis for "said leading side".

Claims 28, 31, 32, 34, 42 and 43 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yaacobi et al. (6,413,245). Yaacobi et al. disclose connecting end 56, hollow spatula-like member 52, 54 including an arcuate distal section 52 having a radius of curvature of about 11.5 mm to about 14 mm as recited

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from col. 64 to col. 6, line 4 (which is within the disclosed range of applicant's invention of about 10 mm to about 40 mm as recited in original claim 35 and about 8 mm to about 12 mm as recited on page 16, lines 11-12 of the specification), one side (e.g. the side shown in figure 3C which faces the top of the page, noting col. 4, lines 55-57) having a plurality of apertures (described in col. 4, lines 57-58 and shown in figure 3C, for example). The Yaacobi et al. instrument is inherently capable of separating epithelium of a cornea, particularly since it can be made of a very small size as indicated in col. 4, lines 63-66. Alternatively, it would have been obvious that the Yaacobi et al. instrument is capable of separating epithelium of a cornea for this reason. As to claim 34, note col. 5, lines 39-40. As to claim 42, note col. 5, lines 66-67. As to claim 43, note col. 5, lines 52-53.

Claims 33 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaacobi et al. (6,413,245). Yaacobi et al. fail to disclose the specific claimed dimensions and number of apertures. However, Yaacobi et al. disclose that dimensions and number of apertures other than those which are listed may be used (col. 4, lines 61-62 and 64-66 and col. 8, lines 16-19). It would have been obvious to use the specific claimed

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dimensions and number of apertures in the Yaacobi et al. instrument for this reason.

Claims 29 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaacobi et al. (6,413,245) in view of Doshi et al. (6,443,944). Yaacobi et al. disclose the spatula-like member as having a circular rather than a trapezoidal cross-sectional shape as claimed. However, Doshi et al. teach that the tubular member of a surgical instrument may have a trapezoidal rather than a circular cross-sectional shape (col. 6, lines 47-52) apparently since each shape would work equally well. It would have been obvious to make the cross-sectional shape of the Yaacobi et al. instrument trapezoidal rather than a circular for this reason.

Applicant's arguments filed Oct. 24, 2005 have been fully considered but they are not persuasive for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the

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organization where this application or proceeding is assigned is
(571)273-8300.

mht
12/16/05

A handwritten signature in black ink, appearing to read "Michael Thaler", with a stylized flourish at the end.

MICHAEL THALER
PRIMARY EXAMINER
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